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| EXAMINER | |
|---|---|
| CASCA, FRED A | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/562,566 | CHIPCHASE ET AL. | |
| | Examiner | Art Unit | |
| | FRED A. CASCA | 2617 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *29 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) *14-49* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

*1.* This action is in response to applicant's amendment filed on June 29, 2009. Claims 1-49 are still pending of which claims 14-49 are withdrawn from consideration in the present application.

### *Election/Restriction*

2. Applicant elected claims 1-13 in response to examiner's request for Election/Restriction. However, the applicant did not indicate that the election is without traverse. The examiner asserts that the applicant's election is treated as an election without traverse. See MPEP § 818.03(a).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 3-5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 3 recites the limitation "the mobile communication device to transmit the said communication" in lines 2-3 and claim 1 recites that "a communication received from the network". There is insufficient explanation of how the same communication can be transmitted by both the mobile communication device and the network.

Claims 4 and 5 are rejected for the same reasons as set forth in the rejection of claim 3 above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1, 3-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley et al (US 6,728,712 B1) in view of Kanefsky et al (US 2002/0026500 A1).

Referring to claim 1, Kelley discloses a communication device for communication in a network (abstract, col. 1, lines 12-20 and figure 1,"client computer", "network server"), the device comprising:

memory for storing a set of tags (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark", note that bookmarks (tags) are stored in the database 14 of the client computer) and for each tag an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines 10-11, "web address or URL");

a user interface (Fig. 1, "screen", "mouse-controlled curser"), whereby a user can select one of the tags and thereby cause the mobile communication device to initiate a connection to the network address associated with the tag (Col. 1, lines 15-20);

a configuration means arranged to automatically alter the network address associated with a tag in response to a communication received from the network (Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered).

Kelley is silent on whether the communication device is a mobile communication device.

In the same field of endeavor, Kanefsky discloses a mobile communication device creating bookmarks for web addresses from a network (Fig. 1, Par. 26 and Par. 27, lines 31-38, "mobile device 10", "bookmark application", "mobile device 10 to store desired URLs as bookmarks").

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the device of Kelley by incorporating the teachings of Kanefsky such that the tagging operations of Kelley is applied to mobile devices, for the purpose of expanding the advanced services to a larger group of subscribers, and thus providing an efficient communication system.

Referring to claim 3, the combo of Kelley/Kanefsky discloses the mobile communication device as claimed in claim 1 and further discloses the user interface having a mode whereby a user can cause the mobile communication device to transmit the said communication (Kelley, Col. 1, lines 46-50).

Referring to claim 4, the combo of Kelley/Kanefsky discloses the mobile communication device as claimed in claim 3 and further discloses device is arranged to transmit the said communication automatically (Kelley, Col. 1, lines 43-45).

Referring to claim 5, the combo of Kelley/Kanefsky discloses the mobile communication device as claimed in claim 4, and further disclose the device being arranged to detect a service provider of the network (Kelley, inherent e.g., by selecting a bookmark) to which it is connecting, and to transmit said communication in response to a change in the service provider (Kelley, Col. 1, lines 43-45).

Referring to claim 6, the combination of Kelley/Kanefsky discloses the mobile communication device as claimed in claim 1 and further discloses that the tags and their associated network addresses are stored in a database (Kelley, Figure 1 and Col. 4, lines 1-15 and the rejection of claim 1 above).

The combination is silent on whether the tags and their associated network addresses being stored in a dynamic service card as claimed.

It would have been an obvious design choice to modify the combination of Kellely/Kanefsky such that the tags and their associated network addresses would be stored in dynamic service card since the applicant has not indicated that storing the tags and associated addresses in the dynamic service card would solve any stated problem or is for any particular purposes and it appears that having the tags and associated addresses stored in the database of Kelley would perform equally well.

Referring to claim 7, the combo of Kelley/Kanefsky discloses the mobile communication device as claimed in claim 1, and further discloses the network address associated with the tag comprising at least one of: a telephone number; an email address; an uniform resource locator (Kelley, Col. 1, lines 12-15, "URL").

Referring to claim 8, Kelley discloses a communication network means arranged to communicate with at least one communication device (Fig. 1, abstract, and col. 1, lines 12-20), said network means comprising:

a memory for storing a set of tags and for each tag an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 1-8, Col. 4, line 39-40, "database 20", "HTML tags to be converted by a web browser to be displayed on a monitor", "database 16");

a communications means arranged to communicate with the at least one communication device at least one instruction containing a tag and an associated network address (Fig. 1, Col. 1, lines 15-20, Col. 3, lines 66, Col. 4, lines 2-17, "client/network system", "Database 14 ... having address ... URLs ... through network server 18", note that the network communicates with the client (device) when the tag is associated with a network address).

Kelley is silent on whether the communication device is a mobile communication device.

In the same field of endeavor, Kanefsky discloses a mobile communication device creating bookmarks for web addresses from a network (Fig. 1, Par. 26 and Par. 27, lines 31-38, "mobile device 10", "bookmark application", "mobile device 10 to store desired URLs as bookmarks").

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the device of Kelley by incorporating the teachings of Kanefsky such that the tagging operations of Kelley is applied to mobile devices, for the purpose of expanding the advanced services to a larger group of subscribers, and thus providing an efficient communication system.

Referring to claim 9, the combination of Kelley/Kanefsky discloses the communication network means as claimed in claim 8, and further discloses the at least one instruction instructs the mobile communication device to automatically alter the network address associated with a tag stored in the mobile communication device to the network address associated with a tag stored in the network means (Kelley, Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered).

Referring to claim 10, the combination of Kelley/Kanefsky discloses the communication network means as claimed in claim 8, and further discloses the communication network means further comprising an additional memory (Fig. 1, database 16), the additional memory for storing for at least some of the mobile communication devices a list of tags associated to that device (Kelley, Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file

called bookmark", note that bookmarks (tags) are stored in the database 14 of the client computer)

and, wherein the communication means are arranged to instruct that device only to alter the network addresses associated with the tags associated with the mobile communication device identified in the list (Kelley, Col. 1, lines 43-47).

Referring to claim 12, Kelley discloses a communications system (abstract, col. 1, lines 12-20 and figure 1), said system comprising:

a communication device for communication in a network (col. 1, lines 12-20 and figure 1,"client computer", "network server"), the device comprising memory for storing a set of tags and for each tag an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 8-1, Col. 4, line 39-40, "HTML tags to be converted by a web browser to be displayed on a monitor", "Database 14 is conventionally referred to a bookmark database", "store the web address or URL on a file called bookmark", note that bookmarks (tags) are stored in the database 14 of the client computer) and for each tag an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines 10-11, "web address or URL"), a user interface (Fig. 1, "screen", "mouse-controlled curser"), whereby a user can select one of the tags and thereby cause the mobile communication device to initiate a connection to the network address associated with the tag (Col. 1, lines 15-20), and

a configuration means arranged to automatically alter the network address associated with a tag in response to a communication received from the network (Col. 3, lines 50-65, Col. 4, lines 23-26, "automatically updates the web address or URL in the bookmark

file of a client", This change file is created by the server after it receives a record of a new URL from the owner of the web page", note that in response to a network server changing a URL address the network address associated with the tag (URL) is automatically altered); and a communication network means arranged to communicate with the communication device (Fig. 1, abstract, and col. 1, lines 12-20),

said network means comprising a memory for storing a set of tags and for each tag an associated network address (Fig. 1, Col. 1, lines 12-15, Col. 4, lines, 1-8, Col. 4, line 39-40, "database 20", "HTML tags to be converted by a web browser to be displayed on a monitor", "database 16"), a communications means arranged to communicate with the at least one mobile communication device at least one instruction containing a tag and an associated network address (Fig. 1, Col. 1, lines 15-20, Col. 3, lines 66, Col. 4, lines 2-17, "client/network system", "Database 14 ... having address ... URLs ... through network server 18", note that the network communicates with the client (device) when the tag is associated with a network address).

Kelley is silent on whether the communication device is a mobile communication device.

In the same field of endeavor, Kanefsky discloses a mobile communication device creating bookmarks for web addresses from a network (Fig. 1, Par. 26 and Par. 27, lines 31-38, "mobile device 10", "bookmark application", "mobile device 10 to store desired URLs as bookmarks").

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the device of Kelley by incorporating the teachings of Kanefsky such that the tagging operations of Kelley is applied to mobile devices, for the purpose of expanding the advanced services to a larger group of subscribers, and thus providing an efficient communication system.

Referring to claim 13, Kelley discloses a communication system (abstract and Fig.1), comprising: communication devices (Figure. 1, "client computer", "client computer 2), and a network (Fig. 1, Network server), and in which network addresses stored in association with user selectable tags (Col. 1, lines 11-20, Col. 3, lines 50-66 and Col. 4, lines 1-12) are automatically updated by one of the devices based on the devices context (Col. 4, lines 5-35 and Col. 1, lines 40-50).

Kelley is silent on whether the communication device is a mobile communication device.

In the same field of endeavor, Kanefsky discloses a mobile communication device creating bookmarks for web addresses from a network (Fig. 1, Par. 26 and Par. 27, lines 31-38, "mobile device 10", "bookmark application", "mobile device 10 to store desired URLs as bookmarks").

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the device of Kelley by incorporating the teachings of Kanefsky such that the tagging operations of Kelley is applied to mobile devices, for the purpose of expanding the advanced services to a larger group of subscribers, and thus providing an efficient communication system.

7. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelley et al (US 6,728,712 B1) in view of Kanefsky et al (US 2002/0026500 A1) and further in view of Green (US 2002/0077080 A1).

Referring to claim 2, the combination of Kelley/Kanefsky discloses the mobile communication device as claimed in claim 1, and further discloses wherein said device is capable of communicating with the network to request said network to transmit a communication

automatically altering the network address associated with a tag (Kelley, Col. 1, lines 40-50 and col. 3, lines 50-65).

The above combination is silent about the device comprising a location estimator for estimating the location of the mobile communication device.

Green discloses a mobile device that comprises a location estimator for estimating the location of the mobile communication device (Par. 19).

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the above combination such that the mobile communication device of Kelley/Kanefsky would be able to estimate its location, for the purpose of letting the network informed of its location, and thus providing an efficient communication system.

The combination above is silent on whether the mobile device would transmit a communication request requesting automatically altering of the network address with a tag being in dependence on the estimated location in the format claimed.

It would have been an obvious design choice to modify the combination such that the terminal would request transmit a communication request requesting automatically altering the network address with of a tag in dependence on the estimated location since the applicant has not disclosed that altering the network address of a tag in dependence on the estimated location would solve any stated problem or is for any particular purpose, and it appears that altering the addresses of tags manually by the user based on location would perform equally well.

Claims 11 is analogous to claim 2. Thus, it is rejected for the same reasons set forth in the rejection of claim 2 (see rejection of claim 2 above).

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED A. CASCA whose telephone number is (571)272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617

/Fred A. Casca/

Examiner, Art Unit 2617